

## **REMARKS**

This communication is responsive to the Office action dated August 27, 2004. Claims 1-43 are pending in the application. In the Office action, the Examiner restricted the above-identified patent application, requesting election of a single group of claims and a single species of invention for prosecution under 35 U.S.C. § 121. In response, applicants hereby elect, without traverse, **Invention I** (claims 1-31 and 43) for prosecution in this application. Applicants are unsure whether they need to elect a species, since the species are specified in terms of nonelected claims. Nevertheless, to the extent that such an election is necessary, and subject to their request (stated below) that the need for an election of species be reconsidered, applicants provisionally elect **Species A** (claims 32-37) for prosecution in the application.

### **I. Restriction Requirement**

The Examiner stated that the pending claims are directed to two distinct inventions, requesting election of one of the following two inventions for prosecution:

Invention I: Claims 1-31 and 43, drawn to a guide.

Invention II: Claims 32-42, drawn to a medical method.

In response, applicants hereby elect, without traverse, **Invention I** (claims 1-31 and 43) for prosecution in this application. Applicants have canceled the remaining, nonelected claims, 32-42, without prejudice, reserving their right to pursue these claims, with or without amendment, in the future.

### **II. Election Requirement**

The Examiner further stated that the pending claims are directed to two patentably distinct species of the claimed invention, requesting election of one of the following two species for prosecution:

Species A: Claims 32-37.

Species B: Claims 38-42.

Applicants are unsure whether the Examiner has asked them to elect a species following election of Invention I, since the species are specified in terms of claims from Invention II (which applicants did not elect). If the Examiner has asked for an election, applicants respectfully request reconsideration of that request, contending that the election requirement is improper because the specified "species" are not mutually exclusive. Moreover, applicants also traverse the Examiner's assertion that "no claims appear generic." In particular, applicants believe that all of the claims in Invention I (including all of the independent claims) are generic, in that they read on both of the "species" identified by the Examiner (i.e., could be used to practice the methods recited in the method claims designated as "species" by the Examiner). Nevertheless, pending review of their request for reconsideration, applicants provisionally elect **Species A** (claims 32-37) for prosecution in this application.

The MPEP states that "[c]laims to be restricted to different species must be mutually exclusive" (i.e., they must recite the mutually exclusive characteristics of the species). MPEP 806.0(f). The general test is that "one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first." Id.

The pending claims do not satisfy the test for mutual exclusivity. In particular, the alleged "species" overlap significantly. For example, Species A recites a bone plate with a threaded aperture; however, the bone-repair device in Species B encompasses (though is not limited to) a bone plate with a threaded aperture. Similarly, Species B recites connecting a bone repair device to a bone; however, the bone plate in Species A

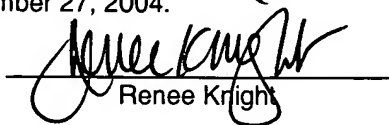
can be connected to a bone. Consistent with his overlap, applicants believe that all of the elected claims can be read on both Species A and Species B, with none of the elected claims readable on just one of the species.

In summary, because the pending claims neither define nor recite mutually exclusive characteristics of Species A and Species B, applicants believe that the election requirement is improper. Nevertheless, pending review of this request for reconsideration, applicants provisionally elect Species A for prosecution in the application. Moreover, as indicated above, applicants believe that each of the elected claims, 1-31 and 43, is readable on the elected species, in the sense that each of the elected claims could be used to practice the method recited in Species A.

Applicants believe that this communication is fully responsive to the Office action. However, if there are any remaining matters, the Examiner is encouraged to call the undersigned attorney at (503) 224-6655.

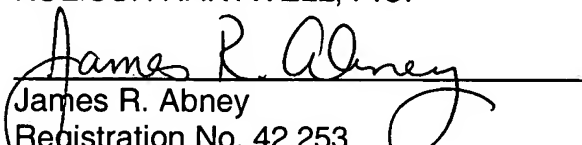
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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on September 27, 2004.

  
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Respectfully submitted,

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